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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,596	03/10/2004	Paul D. Mannheimer	(P0236S-2) TYHC:0075-2/FL	6350
52144	7590	12/15/2006	EXAMINER	
FLETCHER YODER (TYCO INTERNATIONAL, LTD.) P.O. BOX 692289 HOUSTON, TX 77269-2289				
		WINAKUR, ERIC FRANK		
		ART UNIT	PAPER NUMBER	
		3768		

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/798,596	MANNHEIMER ET AL.	
	Examiner	Art Unit	
	Eric F. Winakur	3768	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 October 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-7 and 9-53 is/are pending in the application.
 4a) Of the above claim(s) 27-45 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-7,9-26 and 46-53 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

2. Newly submitted claims 27 - 45 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The previously presented claims were drawn to an embodiment where the sensor memory stores formulas and functions, wherein the embodiments presented in the newly submitted claims are drawn to an invention that includes a sensor that stores only coefficients and has an oximeter monitor that stores the formulas.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 27 - 45 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

3. Claims 1 - 7, 9 - 26, and 46 - 53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection is maintained for the reasons set forth in the prior Office action.

Response to Arguments

4. Applicant's arguments filed 2 October 2006 have been fully considered but they are not persuasive. Contrary to Applicant's assertion that the quoted passage "discloses compressing functions to allow storage of those functions on a limited sensor memory", the quoted section does not explicitly or inherently teach storing the functions on the sensor memory. Further, although Applicant alleges that "[o]ne skilled in the art would recognize that the very reason for compressing the functions (formulas) is to allow the formulas to be stored on a memory with limited capacity. If the formulas only were stored on the monitor memory, there would be no need to compress them for a limited sensor memory" this is not persuasive. As the quoted passage indicates that "any function can be used" and "[a]ny representation of a function could be used", the chosen function could be quite complex, involving multiple variables and constants, thereby requiring multiple coefficients to be stored on the memory. Such a situation would overwhelm the capacity of the limited sensor memory. However, mathematical assumptions and approximations may be employed to "compress" the function to remove the need to store some of the coefficients and allow the limited memory to store the needed data.

Further, it is noted that except for the single paragraph that Applicant relies upon, which never explicitly discloses storing data on a memory (application page 9, lines 13 - 20), and as detailed in the prior Office action, every other disclosure in the specification with explicit teachings relates to storing values (coefficients) on the sensor memory and having formulas/functions resident on the monitor. In light of the teaching of the

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remainder of the specification, Applicant's conclusions seem to be contrary to what one of ordinary skill in the art would recognize. It appears that Applicant has fit an interpretation of this passage to the claims without regard to the teachings of the rest of the specification. However, it is improper to assert that one of ordinary skill in the art would "recognize" a conclusion that is contrary to the teachings of the specification.

Assuming, *arguendo*, that Applicant's assertion is correct in that the quoted portion teaches storing functions on a limited sensor memory, the specification still does not teach or suggest storing two sets of coefficients and two functions, as set forth in the claims. In fact, if the formulas were stored on the memory this would eliminate the need to store coefficients on the memory, as this would merely duplicate information contained in the formula without enhancing the usefulness of the device. That is, storing both formulas and coefficients would waste limited memory space, but there is no reason why this would be done, as the passage that Applicant relies upon teaches away from using the limited memory in a wasteful manner.

Thus, regardless of how the teaching of page 9, lines 13 - 20 is viewed, either as not teaching storing the functions on the sensor memory in context of the remainder of the specification or as teaching storing the functions, according to Applicant's assumptions, it is not reasonable to conclude that one of ordinary skill in the art would recognize the claimed invention in the disclosure. Therefore, the rejection of the claims under 35 USC 112, first paragraph is proper and is hereby maintained.

Conclusion

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5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric F. Winakur whose telephone number is 571/272-4736. The examiner can normally be reached on M-Th, 7:30-5; alternate Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eleni Mantis-Mercader can be reached on 571/272-4740. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or ~~571-272-1000~~.


Eric F Winakur
Primary Examiner
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